

REMARKS

Claims 1-24 remain pending in the present application. Applicant respectfully requests reconsideration by the Examiner in light of the following remarks.

First, the Applicant would like to thank the Examiner for extending the courtesy of an interview with the undersigned, as one of the Applicants and as a representative of the Applicants, on January 12, 2007, to discuss the above identified application and the reconsideration of the pending claims thereof. The Applicant acknowledges the content of the interview summary (Form PTOL-413) prepared by the Examiner, dated January 12, 2007. Furthermore, the remarks submitted below include the issues addressed in the interview and may be considered a summary of the interview.

The Examiner has rejected claims 1-6, 9, 11-14, 17 and 19-24 under 35 U.S.C. §103(a) as being unpatentable over Woolbright (U.S. Patent No. 5,658,098) in view of Roskin (U.S. Patent No. 7,000,347) and Bergevin (U.S. Patent No. 5,586,408); claims 7, 8, 15, and 16 under 35 U.S.C. §103(a) as being unpatentable over Woolbright (U.S. Patent No. 5,658,098) in view of Roskin (U.S. Patent No. 7,000,347), Bergevin (U.S. Patent No. 5,586,408) and Skuba (U.S. Patent No. 6,336,291); claims 10 and 18 under 35 U.S.C. §103(a) as being unpatentable over Woolbright (U.S. Patent No. 5,658,098) in view of Roskin (U.S. Patent No. 7,000,347), Bergevin (U.S. Patent No. 5,586,408) and White-Wexler et al (U.S. Patent No. 5,501,040); and 1-7 and 9-12 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,571,529 in view of Bergevin; claims 1-4, 13, 15 and 16 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,695,544 in view of Bergevin; and claims 13-15, and 17-23 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S.

Patent No. 6,817,154 in view of Bergevin. In response, Applicants respectfully traverse the above-mentioned rejections and respectfully request reconsideration by the Examiner in view of the following remarks.

With regards to the above mentioned rejections of the claims 1-24, particularly independent claims 1 and 13, under 35 U.S.C. §103(a) as being unpatentable over Woolbright in view of two or more of Roskin, Bergevin, Skuba and White-Wexler, the Applicant respectfully traverses the Examiners suggestion that Woolbright includes all of the limitation of the presently claimed invention except for a top panel, vegetation seeds (limitation of claim 13) and a plurality of apertures positioned on the top panel (limitation may also or alternatively include apertures positioned on the wall assembly). The Applicants note that Woolbright does not disclose or suggest a number of other limitations identified in the claims. For example, the primary reference, Woolbright '098, also fails to disclose limitations including, but not limited to, the following: 1) a deterioration resistant retaining wall having planter blocks including "*chambers*" for receiving and retaining fill material and seeds and/or vegetation, and 2) a deterioration resistant retaining wall that includes at least one or more of the aperture(s) positioned on the visible front panel(s) of the wall assembly to allow vegetation to visibly grow to the exterior of the deterioration resistant retaining wall.

The Examiner bears the initial burden in establishing a prima facie case of obviousness when rejecting claims under 35 U.S.C. §103. In re Piasecki, 745 F.2d 1468, 223 USPQ 758 (Fed. Cir. 1985); In re Reuter, 651 F.2d 751, 210 USPQ 249 (CCPA 1981). If the Examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of non-obviousness.

To properly establish a prima facie case of obviousness, MPEP § 706.02(j) identifies three basic criteria that must be met. First, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. Second, there must be some suggestion or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or combine reference teachings. Finally, there must be a reasonable expectation of success. In *re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As previously suggested, a prima facie case of obviousness concerning the present application has not been established since the references cited by the Examiner do not disclose all of the claim limitations in the present application. The method of construction of a deterioration resistant retaining wall and the deterioration resistant retaining wall as claimed in the present application include a plurality of planter blocks that include a wall assembly that is adjoined to the top panel and bottom panel to form a *chamber* for receiving and retaining fill material. A *chamber* is generally understood to be an enclosed space or compartment. The forming of a chamber in planter block of the present invention by adjoining the wall assembly with the top panel and bottom panel provides added stabilization of the walls of the planter block, especially when filled. A wall formed from a plurality of such planter blocks creates a physical structure that can maintain a sloped terrain from erosion by creating a physical barrier in front of the sloped surface unlike simply vegetating an exposed sloped terrain. The walls of the present invention hold back the soils and other aggregate present in the sloped surface and allows for the control of water and wind movement over the sloped terrain while still providing the aesthetics of vegetation. The applicant should also note that even though an enclosed chamber is formed, one or more walls and/or panels of the wall assembly, top panel and bottom panel may

include one or more apertures to allow for additional plant and root growth throughout the structure.

Additionally, Woolbright and the other cited references do not disclose or suggest a deterioration resistant retaining wall and a method of constructing such a wall that includes a plurality of planter blocks that have one or more apertures positioned on the visible front panel(s) of the wall assembly to allow vegetation to visibly grow to the exterior of the deterioration resistant retaining wall. The intention of the present invention is to provide a wall structure that can stabilize and/or prevent erosion or movement of a sloped or rugged surface or terrain while still providing a vegetated appearance. As previously explained, the construction of a retaining wall including a plurality of the planter block of the present invention assist in forming a rigid structure that provides a barrier to earth movement caused by elements, such as gravity or water erosion while still allowing for vegetative growth through the front panel(s) to the visible surface of the retaining wall. The growth of vegetation through the front panels allows for the entire retaining wall to support visible vegetation thereby eliminating the unsightly appearance of a retaining wall and providing the aesthetics of a completely vegetated slope. Woolbright and all of the other cited references fail to disclose or suggest such a retaining wall or method of constructing such a wall that can provide the structural integrity of the claimed retaining wall, which functions to protect the terrain from earth movement and/or water erosion and additionally provides vegetative growth through the visible front panel surfaces of the planter blocks.

The Examiner has also failed to provide a prima facie case of obviousness when rejecting claims under 35 U.S.C. §103 by failing to provide an adequate suggestion or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or combine reference teachings. The teaching or suggestion to

make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. In re Vaeck, 947 F/2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Nothing identified in the cited references provided by the Examiner would suggest their combination to provide for the methods of constructing a retaining wall structure and for a retaining wall that stabilizes a sloped terrain or provides a structural barrier and is further intended to display vegetation to its visible front panel surface(s). Woolbright is the only reference directed to a retaining wall. As previously mentioned, Woolbright does not provide the structural limitations of the claimed invention and further does not disclose or suggest the vegetation of each of the building blocks of the wall. While Woolbright discloses the potential for root growth to stabilize the wall, it does not disclose or suggest apertures positioned on the front panel(s) that would provide substantial coverage of the front surface of such structures for visible vegetative growth through the front surface of each planter block since such apertures for growth are found only on the bottom panel away from the visible portions of each building blocks.

Furthermore, the Examiner has utilized four secondary references, Roskin, Bergevin, Skuba and White-Wexler that are not directed to nor disclose or suggest retaining wall construction or retaining walls. Moreover, the four secondary references are not related to nor disclose or suggest vegetated retaining walls and the method of constructing such vegetated walls. For example, Roskin has been cited to address Woolbright's omission of a top panel and White-Wexler has been cited to address Woolbright's omission of interior partitions in the retaining wall blocks of the present invention. Roskin discloses a vase for cut flowers and White-Wexler discloses flower pots or planters. A person of ordinary skill in the art would not look to

the flower vase or flower pot technology for suggestions related to structural limitations of a slope stabilizing structure like a retaining wall. Vases for cut flowers and flower pots or planters are generally not considered as structural building materials and would not be considered by a person of ordinary skill in the art as references that would provide guidance on such technology. Additionally, Bergevin and Skuba are directed to vegetated matting materials and are not related to structural building materials, particularly those utilized in the construction of retaining walls. Therefore, a person of ordinary skill in the art would not look to these references for guidance in vegetated retaining wall technology and the construction steps for such walls. In view of the above remarks, the Applicants respectfully request that the Examiner reconsider the rejection of the pending claims and find claims 1-24 allowable.

The Examiner has also provisionally rejected claims 1-7, 9-13, 14, 15 and 17-23 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent Nos. 6,571,529 or 6,817,154 in view of Bergevin. The Applicants respectfully traverse the rejection and disagree with the Examiners assertion that “it would have been obvious to those of ordinary skill in the art of retaining walls at the time the invention was made to modify the device claimed in either the ‘529, or ‘154 references such that it would include a “plurality of apertures”. Moreover, the Applicants would submit that it would not be obvious to those of ordinary skill in the art to modify the walls disclosed in the ‘529 or ‘154 references to include a plurality of apertures on the visible front panel(s) of each block. This would defeat the purpose of such structures to provide a retaining wall that would hold back the sloped terrain and prevent vegetation from coming through. Furthermore, the same arguments above related to the 35 U.S.C. 103 rejections are applicable in response to the obviousness type double patenting rejections, which utilize the ‘529 and ‘154 patents, in that the arguments addressing Woolbright

as the primary reference are also applicable to the rejections utilizing the '529 and '154 as the primary references. In view of these arguments the Applicant respectfully requests that the Examiner reconsider and withdraw the obviousness type double patenting rejections that apply the '529 and '154 references.

Finally, the Examiner has also provisionally rejected claims 1-4, 13, 15 and 16 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent Nos. 6,695,544 in view of Bergevin. The Applicants respectfully traverse the rejection and disagree with the Examiners assertion that "it would have been obvious to those of ordinary skill in the art of retaining walls at the time the invention was made to modify the device claimed in either the '529, '544 or '144 references such that it would include a plurality of apertures". However, to advance prosecution of this Application and to obtain allowance on allowable claims at the earliest possible date, the Applicants agree to file a terminal disclaimer in compliance with 37 CFR 1.321(c) to overcome the rejection based on nonstatutory double patenting upon receiving notice of the allowability of the claims. It is noted that no admission may be inferred by this response or any terminal disclaimer filed in the present application and the Applicants reserve the right to pursue similar claims in the future.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,

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